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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,705	04/13/2006	Yuichi Futa	2006_0545A	2366
52349 7590 06/18/2010 WENDEROTH, LIND & PONACK L.L.P. 1030 15th Street, N.W. Suite 400 East Washington, DC 20005-1503				
EXAMINER				
LIM, SENG HENG				
ART UNIT		PAPER NUMBER		
3714				
NOTIFICATION DATE		DELIVERY MODE		
06/18/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ddalecki@wenderoth.com
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Office Action Summary

Application No.

10/575,705

Applicant(s)

FUTA ET AL.

Examiner

SENG H. LIM

Art Unit

3714

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/22)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

This office action is in response to the amendment filed on 3/15/2010 in which applicant cancelled claims 1-23; added claims 24-36; and responds to the claim rejections. Claims 24-36 are pending.

Response to Arguments

Applicant's arguments with respect to claims 24-36 have been considered but are moot in view of the new ground(s) of rejection.

Election/Restrictions

Newly submitted claims 28-36 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Applicant originally presented two game execution apparatus with two different game recording medium with two game programs respectively. Applicant is now claiming one single execution apparatus being able to receive the two different game recording medium in claims 28-36; while claims 24-27 still has the original invention comprising two game execution apparatus with two different game recording medium with two game programs respectively

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 28-36 are withdrawn from consideration

as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 24-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant suggested support for newly added claims are supported in at least Fig. 5, 10, 24 and 26. From examining the written specification, Examiner understands the invention comprises two different gaming apparatus wherein each gaming apparatus comprises its own game storage medium (i.e. DVD, 500 and cartridge, 400) with a first and second game program stored in each game storage medium respectively. Both gaming apparatus has a common memory card that is useable and readable by both gaming apparatus which holds characteristic information. The gaming apparatus checks authenticity of the memory card, and only when the authenticity has been ensured, character data is read from the memory card [0020-0028]. The written specification does not support applicant's newly added claim wherein the second game recording medium records prohibition information that

prohibits an attribute of a character from changing, wherein the attribute being the same as the attribute of the character that appears in the first game.

Claims 24-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not teach how prohibition information in the second game recording medium prohibits the attributes of the character that appears in the second game from being changed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Sato (US 4,858,930).

Re claim 24. Sato discloses a game system comprising a first game recording medium, a second game recording medium, a first game execution apparatus, and a second game execution apparatus (Fig. 1),

wherein the first game recording medium records therein a first game program and permission information (10: Fig. 1), the first game program indicating a procedure for proceeding with a game, the permission information indicating that, only in a first game that proceeds in accordance with the first game program, an attribute of a character that appears in the first game is permitted to be changed (i.e. as the player continues progressing, a permission is granted for the character's abilities to grow, col. 4, lines 33-36),

wherein the second game recording medium records therein a second game program and prohibition information (30: Fig. 1), the second game program indicating a procedure for proceeding with the game, the prohibition information indicating that, only in a second game that proceeds in accordance with the second game program, an attribute of the character that appears in the second game is prohibited from being changed, the attribute being the same as the attribute of the character that appears in the first game (i.e. the cartridge, 50, holds the character's attributes and if not presented in the commercial game, the character attributes are prohibited from being changed, col. 6, lines 40-45),

wherein the first game execution apparatus includes:

a first program reading unit operable to read the first game program and the permission information from the first game recording medium (14: Fig. 1);

a first input unit operable to receive an inputting operation from a user (i.e. game controller); and

a first game execution unit operable to (a) in response to the inputting operation received by the first input unit, proceed with the first game in accordance with the procedure indicated by the first game program read by the first program reading unit, (b) display the character so as to appear in the first game as the first game proceeds, and (c) in response to an inputting operation from the user requesting to change the attribute of the character that appears in the first game, change the attribute of the character that appears in the first game in accordance with the permission information (i.e. as the player continues progressing, a permission is granted for the character's abilities to grow, col. 4, lines 33-36), and
wherein the second game execution apparatus includes:

a second program reading unit operable to read the second game program and the prohibition information from the second game recording medium (34: Fig. 1);

a second input unit operable to receive an inputting operation from the user (i.e. game controller); and

a second game execution unit operable to (a) in response to the inputting operation received by the second input unit, proceed with the second game in accordance with the procedure indicated by the second game program read by the second game reading unit, (b) display the character so as to appear in the second game as the second game proceeds, and (c) contrary to the inputting operation from the user requesting to change the attribute of the character that

appears in the second game, prohibit the attribute of the character that appears in the second game from being changed in accordance with the prohibition information (i.e. the cartridge, 50, holds the character's attributes and if not presented in the commercial game, the character attributes are prohibited from being changed, col. 6, lines 40-45).

Re claim 25. The first game execution apparatus further includes a character reading unit operable to read, from a portable recording medium (50: Fig. 1), character data that indicates the attribute of the character that appears in the first game, and wherein the first game execution unit changes the attribute indicated by the character data read by the character reading unit.

Re claim 26. The first game execution apparatus further includes a character writing unit operable to, when the first game execution unit changes the attribute of the character, overwrite the character data in the portable recording medium with after-change character data indicating the attribute after being changed by the first game execution unit, wherein the character reading unit further reads the after-change character data from the portable recording medium, and wherein the first game execution unit changes the attribute as the first game proceeds, in accordance with the read after-change character data (col. 4, lines 46-50 & 59-68).

Re claim 27. The first game recording medium further records therein a degree of change allowed on the character, in association with the permission information, and wherein the first game execution unit changes the attribute as the first game proceeds, in accordance with the degree of change recorded in the first game recording medium

(i.e. the character's are changed progressively according to player's progress, col. 4, lines 28-36).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see attached USPTO form PTO-892.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seng H. Lim whose telephone number is 571-270-3301. The examiner can normally be reached on 8:30-6:00, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Seng H Lim/

Examiner, Art Unit 3714

/Peter D. Vo/

Supervisory Patent Examiner, Art Unit 3714